REMARKS

Reconsideration of this application is respectfully requested in view of the foregoing amendment and the following remarks.

Claims 1-19 were pending in this application. Claims 1-2, 6-9 and 15 have been amended hereby to clarify the invention. Support for the amendment can be found in the originally filed claims. No new subject matter has been introduced and no claim has been cancelled or added. Accordingly, claims 1-19 will be pending herein upon entry of this Amendment. For the reasons stated below, Applicant respectfully submits that all claims pending in this application are in condition for allowance.

In the Office Action mailed March 2, 2004, claims 1-2, 4-13, 15-17 and 19 (which includes all independent claims 1, 7, and 15) were rejected under 35 U.S.C. § 102(e) as being anticipated by Pollack (U.S. Patent No. 6,505,236, hereinafter Pollack). Claims 3, 14 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Pollack in view of Beyda et al. (U.S. Patent No. 6,275,850, hereinafter Beyda). To the extent any of these rejections might still be applied to claims presently pending in this application, it is respectfully traversed.

Applicant believes Pollack fails to disclose all the elements recited in claim 1. Further, even if Pollack arguably suggests all the elements, Applicant believes Pollack still fails to disclose the order in which the several steps are recited in claim 1. Specifically, claim 1 recites the following steps in the order emphasized by the word "then" as appeared below:

> searching a database of attachment files previously stored in the e-mail server for a copy of the attachment file from the received e-mail communication; and,

if a copy of the attachment file is located in the e-mail server,

then removing the attachment file from the e-mail communication; and

then creating a link from the e-mail communication to the previously stored attachment file in the database.

Pollack fails to teach the above sequence of steps, which is, the removal of the attachment from the e-mail is performed after a comparison is made. In contrast, Pollack teaches a process that executes in the following order: (1) detaching an attachment from an email; (2) storing the detached attachment in storage device; (3) comparing the detached attachment with all stored attachments; and (4) deleting the newly stored attachment from the storage device if a redundant copy is found. Specifically, in the passage of Pollack relied on in the Office Action (column 6, lines 33-65) (emphasis added), Pollack teaches:

> Often, a sender will wish to distribute a single attachment to numerous recipients. Alternatively, two separate recipients may be receiving the same attachment from two different senders. Either way, this results in storage device 26 not being utilized in an efficient fashion, as multiple copies of the same attachment are simultaneously being stored on storage device 26. When an attachment 20' is being stored on storage device 26, attachment comparator 60 compares the attachment being stored to all stored attachments to determine if the newly stored attachment is the same as any stored attachment. Attachment comparator 60 compares the files to determine if the files are the same. In the event that the newly stored file is identical, and therefore redundant, with a file previously stored on storage device 26, redundancy deleter 62 will delete the newly stored attachment so that only a single copy of the file is stored on storage device 26. Further, since this deletion will result in a handle being generated which points to a deleted file, handle redirector 64 will redirect handle 44 so that it properly points to the previously stored attachment. This redirection can occur in several ways. For example, the handle redirection can occur prior to transmitting appended electronic mail item 14' to recipient 22. If this occurs, the handle 44 transmitted to the recipient 22 will contain the accurate address and, therefore, no further redirection is required. Alternatively, the redirection can occur after the appended electronic mail item is transmitted to recipient 22. If this occurs, handle redirector 64 will notify attachment retriever 50 that the specific handle had been redirected and, therefore, when recipient 22 attempts to retrieve

> stored attachment 20' via handle 44, attachment retriever 50 will know that the new storage location of the deleted attachment is actually the storage location of the previously stored attachment.

Thus, it is clear that Pollack discloses storing the attachment (which requires detaching it first) in a storage device, then comparing the newly stored attachment to previously stored files in the storage device. Thus, Pollack fails to disclose "searching a database of attachment files previously stored in the e-mail server for a copy of the attachment file from the received e-mail communication; and, if a copy of the attachment file is located in the e-mail server, then removing the attachment file from the e-mail communication; and then creating a link from the e-mail communication to the previously stored attachment file in the database," as recited in claim 1. Therefore, Applicant believes claim 1 is patentable over Pollack. Dependent claims 2-6 are believed to be patentable at least due to their dependency from an allowable claim.

Each on independent claims 7 and 15 includes limitations similar to claim 1. Accordingly, Applicant believes claims 7-19 are patentable over all references of record.

In view of the foregoing all of the claims in this case are believed to be in condition for allowance. Should the Examiner have any questions or determine that any further action is desirable to place this application in even better condition for issue, the Examiner is encouraged to telephone applicants' undersigned representative at the number listed below.

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